

**REMARKS**

Claims 1-6, 9-14 and 21-26 are all the claims pending in the application. Claims 24-26 are withdrawn from consideration as being drawn to a non-elected invention. Claims 1-6, 9-14 and 21-23 presently stand rejected.

Although the Office Action summary indicates the specification is objected to, the Examiner indicated at paragraph #2 of the Office Action that the objection to the specification has been withdrawn. Clarification is kindly requested.

The drawings filed March 28, 1998 are objected to by the Examiner. Specifically, the Examiner has indicated that the “vertical and horizontal extension of the deformation preventer must be shown or the features canceled from the claims.” Applicant has addressed this objection below in the context of the rejection of claims 21-23 under 35 U.S.C. § 112, first paragraph.

In regard to the claim rejections, claims 21-23 are rejected under 35 U.S.C. § 112, first paragraph; Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Onishi et al. (USP 6,162,381); Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Onishi et al. (USP 6,162,381) in view of Yoshida (JP 4-34995)<sup>1</sup>; Claims 5, 9-13 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Applicant’s Admitted Prior Art (AAPA) and Onishi et al. (USP 6,162,381); Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants’ Admitted Prior Art (AAPA) and Onishi et al. (USP 6,162,381), and further in view of Yoshida (JP 4-34995); Claims 21 and 23 are rejected under 35 U.S.C. §

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<sup>1</sup> The Examiner indicated the incorrect number in the office action.

103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) and Onishi et al. (USP 6,162,381), and further in view of Waratani et al. (JP 4-64414); and Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) and Onishi et al. (6,162,381) and Waratani et al. (JP 4-64414), and further in view of Yoshida (JP 4-34995). For the reasons set forth below, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

### ***Argument***

#### ***112 Rejection***

In regard to the rejection of claims 21-23 under 35 U.S.C. § 112, first paragraph, specifically for the specification failing to provide a "written description of the deformation preventer extending vertical and horizontal to the top and bottom surfaces of the conductor or end portions of the wires", Applicant initially points out that of the three rejected claims, only dependent claim 23 includes this specific requirement. Accordingly, it is assumed that this rejection only applies to claim 23, and not to independent claim 21 or dependent claim 22. Accordingly, immediate withdrawal of the 112 rejection of claims 21 and 22 is requested. Otherwise, a new office action clarifying the 112 rejection as to claims 21 and 22 is requested.

Further, Applicant submits the claimed requirement of claim 23 is, in fact, adequately disclosed in the present application in a manner sufficient to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. In particular, it is well settled that in order to meet the written description requirement, the claimed subject matter need not necessarily be expressly disclosed in the text of the specification of the application. The Court of Appeals for

the Federal Circuit has stated on numerous occasions that “the written description requirement is satisfied by the patentee’s disclosure of “such descriptive means as words, structures, *figures*, diagrams, formulas, etc., that fully set forth the claimed invention.” (See e.g., Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956, 969 (Fed. Cir. 2002)(quoting Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)(emphasis added)). The Court further stated that “the written description requirement is met if “the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter”. *Id.* (quoting Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985)).

Applicant respectfully submits here, that an artisan would easily understand from reading the present specification in view of the figures, as originally filed, that the deformation preventer “traverses both horizontally and vertically across the top and bottom surfaces of the insert conductor”, as recited in claim 23. For example, Fig. 1 clearly shows a deformation preventer 62 traversing both horizontally and vertically across the insert conductor 61. Further, at page 9, lines 24-26, it is disclosed, in reference to Fig. 1, that the deformation preventers 62 are for reinforcing the mechanical strength of conductor 61 and “are provided on both surfaces of the wiring section 64” of conductor 61. Accordingly, even a casual reader, let alone a skilled artisan, would clearly understand from the originally filed disclosure that the inventor had possession of the subject matter of claim 23. For at least this reason, withdrawal of the rejection of claim 23 under the written description requirement of 35 U.S.C. § 112, first paragraph, is requested.

***Prior Art Rejections***

In regard to the §102 rejection of claim 1, Applicant respectfully submits that Onishi fails to teach or suggest at least the recited “deformation preventer provided on both upper and lower surfaces of said conductor and completely covering at least an end of both upper and lower surfaces of said wires.” As discussed above with respect to the §112 rejection, a skilled artisan would understand that the deformation preventer covers the top and bottom surfaces of the wires. Further, it is shown in Fig. 1 that the deformation preventer covers the end of the wires. Thus, no written description problem arises from amending the claim in this manner.

Onishi, on the other hand, discloses a resin molding 112 that if used in the context of the present invention, would suffer from the at least some of the same problems as discussed in the background section of the present application. For example, as seen in Fig. 3, the resin molding 112 of Onishi does not cover the ends of the electrodes, see, for example, electrode 103. The Examiner points to a portion of resin mold 112, “below the four holes”, located at the bottom of Fig. 3, which allegedly covers the end of the wire. However, the alleged wire identified by the Examiner is not “completely” covered, as now required by the claim. To the contrary, the holes referred to by the Examiner appear to directly in-line with the ends of the alleged wires and, thus, the wires at this bottom portion of resin mold 112 are not completely covered.

For at least this reason, Applicant submits that Onishi fails to disclose all the features of claim 1 and, thus, neither claim 1 nor any claim dependent thereon is anticipated by Onishi. Accordingly, claims 1-4 are patentable over Onishi and the rejection should be withdrawn.

In regard to the rejection of claim 6, because Yoshida fails to compensate for the deficiency of Onishi, discussed above, Applicant submits that claim 6, which depends from claim 1, is patentable over the proposed combination of Onishi and Yoshida.

In regard to claims 9-14, independent claim 9 recites similar subject matter to that discussed above in regard to claim 1. Accordingly, for at least the same reasons as set forth above, and because the asserted "Admitted Prior Art" (APA) in Applicant's does not disclose the specific feature, independent claim 9, as well as dependent claims 10-14 are patentable over the proposed combination of APA with Onishi and Yoshida. Withdrawal of the rejection of claims 9-14 is, therefore, requested.

In regard to claims 21-23, independent claim 21 recites similar subject matter to that discussed above in regard to claims 1 and 9. Accordingly, for at least the same reasons as set forth above, and because the additionally asserted prior art reference, Waratani, does not disclose the specific feature, independent claim 21, as well as dependent claims 22 and 23 are patentable over the proposed combination of APA with Onishi, Yoshida and Waratani. Withdrawal of the rejection of claims 21-23 is, therefore, requested.


### ***Conclusion***

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-6, 9-14 and 21-23 and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/045,799

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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